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OFFICE OF PETITIONS

In re Application of
Richard M. Kream
Application No. 10/688,741
Filed: October 17, 2003
Attorney Docket No. None

ON PETITION

This is a decision on the petition under 37 CFR 1.137(b), filed November 4, 2006, to revive the above-identified application.

The petition is **DISMISSED**.

Any request for reconsideration of this decision must be submitted within TWO (2) MONTHS from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. The reconsideration request should include a cover letter entitled "**Renewed Petition under 37 CFR 1.137(b)**." This is **not** final agency action within the meaning of 5 U.S.C. § 704.

A grantable petition under 37 CFR 1.137(b) must be accompanied by: (1) the required reply, unless previously filed; (2) the petition fee as set forth in 37 CFR 1.17(m); (3) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional; and (4) any terminal disclaimer (and fee as set forth in 37 CFR 1.20(d)) required by 37 CFR 1.137(c). Where there is a question as to whether either the abandonment or the delay in filing a petition under 37 CFR 1.137 was unintentional, the Commissioner may require additional information. See MPEP 711.03(c)(III)(C) and (D). The instant petition lack(s) item(s) (1).

The above-identified application became abandoned for failure to reply within the meaning of 37 CFR 1.113 in a timely manner to the final Office action mailed May 20, 2004, which set a shortened statutory period for reply of three (3) months. A reply under 37 CFR 1.113 is limited to an amendment that *prima facie* places the application in condition for allowance or a Notice of Appeal (and appeal fee required by 37 CFR 1.17(b)). No amendment *prima facie* placing the application in condition for allowance or Notice of Appeal (and appeal fee) was timely filed. No extensions of time under the provisions of 37 CFR 1.136(a) were obtained. Accordingly, the above-identified application became abandoned on October 5, 2006.


Further correspondence with respect to this matter should be addressed as follows:

By mail: Mail Stop PETITION
 Commissioner for Patents
 Post Office Box 1450
 Alexandria, VA 22313-1450

By hand: Customer Service Window
 Randolph Building
 401 Dulany Street
 Alexandria, VA 22314

By facsimile: (571) 273-8300
 ATTN: Office of Petitions

Telephone inquiries concerning this decision should be directed to the undersigned at (571) 272-3208.


Karen Creasy
Petitions Examiner
Office of Petitions

Attachment: Advisory Action

Advisory Action Before the Filing of an Appeal Brief	Application No. 10/688,741	Applicant(s) KREAM, RICHARD M.	
	Examiner Robert Landsman, Ph.D.	Art Unit 1647	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 04 November 2006 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☐ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 6 months from the mailing date of the final rejection.
 b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
 (a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
 (b) ☐ They raise the issue of new matter (see NOTE below);
 (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

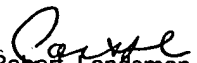
4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
 5. ☒ Applicant's reply has overcome the following rejection(s): see complete discussion of issues below (Box 13).
 6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
 7. ☐ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
 The status of the claim(s) is (or will be) as follows:
 Claim(s) allowed: _____.
 Claim(s) objected to: _____.
 Claim(s) rejected: _____.
 Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
 9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
 10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: _____
 12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____
 13. ☒ Other: See Continuation Sheet.


 Robert Landsman, Ph.D.
 Primary Examiner
 Art Unit: 1647

Continuation of 13. Other:

1. Specification

- A. The objection to the specification has been withdrawn in view of Applicants' amendment to the priority data in the first paragraph.
- B. The specification remains objected to for introducing new matter as discussed on page 2 of the Office Action mailed 7/11/06.
- C. Claim 1 is objected to since the second line recites "a chemically combination."

2. Claim Rejections - 35 USC § 112, first paragraph - scope of enablement

- A. The rejection of claim 1 under 35 USC 112, first paragraph, has been withdrawn in view of the fact that, regardless of the definition of "a peptide moiety" and "a cyclic alkaloid moiety," the claimed compounds still must be a Substance P peptide or morphine. Since the Examiner could not determine exactly where in his arguments or specification Applicant defined these terms, the Examiner is interpreting "a peptide moiety" as a specific known region of a known SP peptide which acts as the binding region for known SP peptides. Similarly, the "cyclic alkaloid moiety" is interpreted as the known cyclic carbon ring of morphine. Therefore, this term does not encompass "derivatives" or "variants" of SP or morphine, only SP and morphine, themselves.

3. Claim Rejections - 35 USC § 112, first paragraph - written description

- A. The rejection of claim 1 under 35 USC 112, first paragraph, is withdrawn for the reasons present above for scope of enablement.

4. Claim Rejections - 35 USC § 112, second paragraph

- A. The rejection of claim 1 under 35 USC 112, second paragraph, has been withdrawn in view of the fact that the term "compact hinge" thought broad, is not indefinite, especially in light of the numerous examples of hinges/linkers provided.
- B. The rejection of claim 1 under 35 USC 112, second paragraph, has been withdrawn in view of the fact that, regardless of the "chemical modification" the compound still must be either SP or morphine. Therefore, the term is not indefinite.
- C. The rejection of claim 1 under 35 USC 112, second paragraph, has been withdrawn since the claim is drawn to inhibiting opioid tolerance.
- D. The rejection of claim 1 under 35 USC 112, second paragraph, has been withdrawn in view of the Examiner's interpretation that the "cyclic alkaloid moiety" of morphine refers to the cyclic carbon ring of the compound.

5. Double Patenting

- A. The rejection of claim 1 as not being patentably distinct over claims in US Patent 6,881,829 has been withdrawn in view of the fact that the claims of the patent and present application were restricted in the parent case.
- B. The rejection of claim 1 as not being patentably distinct over US Patent 6,759,520 has been withdrawn in view of the fact that the patent is drawn to opioid peptides, whereas the present invention is drawn to non-peptide opioids.

6. Claim Rejections - 35 USC § 102

- A. The rejection of claim 1 under 35 USC 102(e) as being anticipated by US Patent 6,759,520 has been withdrawn in view of the fact that the patent is drawn to opioid peptides, whereas the present invention is drawn to non-peptide opioids.
- B. The rejection of claim 1 under 35 USC 102(f) regarding US Patent 6,759,520 has been withdrawn in view of Applicant's arguments.

7. Claim Rejections - 35 USC § 103

- A. Claim 1 remains rejected under 35 USC 103 as being unpatentable over Wainer in view of Foran. Applicant argues that the BSA linker is not able to cross the BBB. However, there is no requirement that the compounds of the present invention need to cross the BBB and can act peripherally.